

REMARKS

Claims 90-95, 97-102 and 105-108 are currently pending, of which claims 90, 99 and 105 are in independent form. No claims have been amended hereby.

Favorable reconsideration of the present patent application as currently constituted is respectfully requested.

Regarding the Claim Rejections - 35 U.S.C. §103(a)

Claims 90-95, 97-102 and 105-108 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,958,006 to Eggleston et al. (hereinafter the *Eggleston* reference) in view of U.S. Patent No. 5,826,023 to Hall et al. and in further view of U.S. Patent No. 6,289,105 to Murota.

The Office Action has commented as follows with respect to base claim 90:

The Examiner notes that Eggleston does not explicitly disclose that the reply message has the user's mail box address as its originating address. However, Eggleston discloses that reply messages are received by the communication server, the preceding message is retrieved by the server, and a delta routine is applied to reconstruct a replica of the reply message. It is clear that the mobile client does not have independent e-mail functionality. Rather, the host server provides the e-mail address and forwards e-mail to recipients who are unaware of any address

from the mobile client. Therefore, despite [lack of] explicit disclosure that the reply message has the user's mail box address as its originating address, one of ordinary skill in the art would have understood Eggleston to disclose such a feature in the disclosure discussing Figure 9.

Substantially identical reasons are also relied upon for rejecting the remaining base claims, i.e., claims 99 and 105.

Applicant respectfully disagrees and submits that the May 2, 2011 Decision of the Board of Patent Appeals and Interferences in the interference styled *Lazaridis v. Eggleston*, Patent Interference 105,700 (Administrative Patent Judges: Jameson Lee, Richard Torczon and Sally C. Medley) supports Applicant's position that *Eggleston* neither explicitly nor inherently discloses at least the features of configuring a user's first address associated with the messaging host system as the reply mail item's originating address, as set forth in the claims on file. The May 2, 2011 Decision and Judgment may be found at <https://acts.uspto.gov/ifiling/> (by clicking the blue "Interferences" bar to enter the BPAI portal and entering the interference number "105700"), which are also being submitted by Applicant in a supplemental Information Disclosure Statement. The May 2, 2011 Decision specifically addressed --

and rejected -- the BPAI's prior interpretation of identical disclosure in an *ex parte* appeal (Appeal No. 2003-2074) of the involved application (Application No. 09/095,325) and concluded that the *Eggleston* disclosure was entirely lacking in respect of the foregoing features.

Since it is the same *ex parte* Appeal No. 2003-2074 that the Examiner relied upon in the October 15, 2010 Office Action in withdrawing the previously-indicated allowability of claims 90-95, 97-102 and 105-108, Applicant respectfully submits that a reinstatement of the allowability of the pending claims is in order and requests such action.

Reservation of Rights

Notwithstanding the foregoing, Applicant reserves all rights not exercised in connection with this response, such as, e.g., the right to challenge or rebut any tacit or explicit characterization of any reference or of the present claims, the right to challenge any Official Notice(s) taken, the right to challenge or rebut any asserted factual or legal basis of any of the rejections of the present Office Action, or the right to swear behind any cited reference such as provided under 37 C.F.R. §1.131 or otherwise.

Fee Statement

Compared to the highest number previously paid for, the total number of claims and the number of independent claims have not increased. No petition for an extension of the reply period is being made. Applicant is filing herewith a Request for Continued Examination (RCE) of the instant patent application. Accordingly, payment via electronic filing is being authorized in the applicable amount. Applicant believes no additional fees are due for the filing of this Submission. If any additional fees are due or any overpayments have been made, however, please charge or credit our deposit account (Deposit Account No. 03-1130).

SUMMARY AND CONCLUSION

In view of the fact that none of the art of the record, whether considered alone or in combination discloses, anticipates or suggests the present embodiments, as now defined by the independent claims, and in further view of the above amendments and/or remarks, reconsideration of the Action and allowance of the present patent application are respectfully requested and are believed to be appropriate.

Respectfully submitted,

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